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DOCKET NO. 2003.10.004.WS0
U.S. SERIAL NO. 10/696,502
PATENT

REMARKS

Claims 1-19 were originally filed in the present application.

Claims 1-19 are pending in the present application.

Claims 1 – 19 were rejected in the January 25, 2006 Office Action.

No claims have been allowed.

Claim 2 has been amended, above. The Examiner is correct that the phrase "and the transition base transceiver station" was deleted inadvertently in the previous amendment, and appreciates the Examiner's understanding. This claim is amended to restore this phrase, and the claim objection is believed to be obviated.

Claims 1-19 remain in the present application.

Reconsideration of the claims is respectfully requested.

Claims 11, 13 and 14 under 35 U.S.C. § 102(b) were rejected as anticipated by U.S. Patent Publication No. US 2001/0007819 to Kubota ("Kubota"). This rejection is traversed.

The description of Kubota and corresponding arguments of the previous response are incorporated herein by reference. For common reference, the Examiner relies on Kubota's BS 52₁-52₄ to satisfy the claimed "first base transceiver station", Kubota's BS 52₅ to satisfy the claimed "transition base transceiver station", and Kubota's Mth BS 58 as the claimed "second base transceiver station." The Examiner notes that path 100 of Kubota's figure 4 indicates the travel path

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of MS 61. To satisfy the limitations of claim 11, as the Examiner alleges, there must be a soft handoff between BS 52₁-52₄ and BS 52₅, and a hard handoff between BS 52₅ and Mth BS 58.

Kubota describes its process for the transfer of the mobile station between BS 52₅ and Mth BS 58. To do so, Kubota's system first performs a hard handoff to BS 52₅, as described in paragraphs [0096]-[0097]: "Thereafter, MS 61 communicates with a channel that is newly assigned between itself and fifth BS 52₅, and there is established new communication path 122 via first MSC 50₁, second MSC 50₂, third BSC 51₃, and fifth BS 52₅. In this manner, new communication path 122 is established after the inter-switching-center hard hand-off control process is completed." (emphasis added).

Thus BS 52₅ does not appear to function as the claimed "transition base transceiver station." There is no disclosure or teaching of within the Kubota reference of a method of providing reliable hard handoffs between a first wireless network and a second wireless network using a transition base transceiver station as described in these claims. Therefore, Kubota reference fails to disclose, for example, performing a hard handoff for the mobile station between the transition base transceiver station and a second base transceiver station in the second wireless network, as required by amended Claim 11 and its dependants, Claims 13 and 14. Thus, Claims 11, 13 and 14 are patentably distinguishable. Applicants therefore request favorable reconsideration and the withdrawal of the §102 rejection.

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Claims 1-10 were rejected as obvious over U.S. Patent Publication No. US 2002/0051432 to Shin ("Shin") in view of Kubota. These rejections are traversed.

As the Examiner expressly notes, on page 5, that Shin "fails to disclose wherein the base station controller is further operable to perform a hard handoff for the mobile station between the transition base transceiver station and the second base transceiver station". In fact, as described at length in the previous response (the arguments of which are hereby incorporated by reference), Shin teaches performing three successive handoffs, a first soft handoff, a hard handoff and a second soft handoff, to facilitate communications between different CDMA systems or between 2G and 3G systems and thus eliminating the so-called ping-pong effect. Accordingly, the Shin reference specifically teaches away from performing a hard handoff for the mobile station between the transition base transceiver station and the second base transceiver station, as required by amended claims 1 and 6, and respective defendant claims 4-5 and 7-10.

Kubota does teach a hard handoff between two different systems. There is no motivation to combine these references for this teaching, however, and as described above, Shin teaches away from any such hard handoff.

As the Examiner is surely aware, the motivation to combine or modify must be specific to the actual teachings sought to be combined. "In holding an invention obvious in view of a combination of references, there must be some suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to select the references and combine them in the way that would produce the claimed invention." (*Karsten Mfg. Corp. v. Cleveland Golf Co.*, 242 F.3d 1376,

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1385 (Fed. Cir. 2001) emphasis added). "When the references are in the same field as that of the applicant's invention, knowledge thereof is presumed. However, the test of whether it would have been obvious to select specific teachings and combine them as did the applicant must still be met by identification of some suggestion, teaching, or motivation in the prior art, arising from what the prior art would have taught a person of ordinary skill in the field of the invention." (*In re Dance*, 160 F.3d 1339, 1343 (Fed. Cir. 1998), emphasis added).

In this case, the Examiner relies on a single sentence in Kubota for a motivation to add Kubota's hard handoff to Shin's system, despite the fact that Shin teaches away from such a modification. The first sentence of Kubota's paragraph [0024] reads "A hand-off control process needs to be performed between different systems for increasing the quality of services provided to the users of mobile stations." This is certainly true. Shin's system is a handoff control process, and one that teaches away from using Kubota's hard handoff. This sentence provides no motivation at all for one of skill in the art to look to Kubota, and certainly not to modify Shin's system to include the very thing that Shin seeks to avoid. Lacking a proper motivation to modify or combine these references in the specific way as to meet the claimed invention, the Office Action fails to make a *prima facie* obviousness rejection, and is so legally deficient.

The rejections of claims 1-10 are traversed.

Claims 12 and 16-19 were rejected as obvious over Kubota in view of Shin. Claim 15 was rejected as obvious over Kubota. These rejections are traversed.

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The distinctions of parent independent claim 11, discussed above, apply here. As the Examiner expressly notes, on page 5, that Shin also "fails to disclose wherein the base station controller is further operable to perform a hard handoff for the mobile station between the transition base transceiver station and the second base transceiver station", it is clear that the combination of Kubota and Shin, taken together, also does not teach or suggest a "transition base transceiver station" functioning as claimed in independent claim 11. As such, claim 11 and dependent claims 12-19 are all patentable over this combination.

The Examiner further acknowledges that Kubota does not teach "performing the soft handoff when the mobile station reaches an overlap region between the first wireless network and the second wireless network", as in claim 12, and relies on Shin for this teaching. Shin does describe an overlapped portion referred to as an "α sector" (paragraph [0043], lines 3-4 of right column), but does not teach that a soft handoff occurs when the mobile station reaches the "α sector". Rather, paragraph [0043] describes that the soft handoff occurs "[w]hen the strength of the pilot signal from the α sector of cell 'G' reaches a threshold value" (emphasis added). Paragraph [0044] then describes "[a]fter the soft handoff adding the α sector of the cell 'G' region is conducted as the mobile station moves toward the α sector of the cell 'G' region..." (emphasis added). As is clear, any soft handoff occurs before the mobile station reaches the overlapped portion.

As such, claim 12 is further distinguished over the combination of Kubota and shin, and should be allowed.

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SUMMARY

For the reasons given above, the Applicant respectfully requests reconsideration and allowance of the pending claims and that this application be passed to issue. If any outstanding issues remain, or if the Examiner has any further suggestions for expediting allowance of this application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at jmockler@davismunck.com.

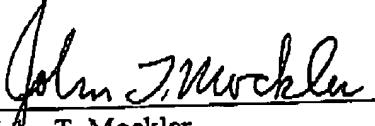
The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Deposit Account No. 50-0208.

Respectfully submitted,

DAVIS MUNCK BUTRUS, P.C.

Date: 22 March 2006

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